

REMARKS

I. Status of the Claims

In the Office Action mailed March 10, 2008, the Examiner objected to claims 5, 15, 19, 20, 30, 35, and 45; rejected claims 1-3, 5-8, 11, 12, 16-18, 20-23, 26, 27, 31-33, 35-38, 41 and 42 under 35 U.S.C. § 112, second paragraph; rejected claims 31-45 under 35 U.S.C. § 101, as being directed to non-statutory subject matter; and rejected claims 1-45 under 35 U.S.C. § 103(a), as being unpatentable over *Marshall* (U.S. Patent Publication No. 2002/0116266) in view of *Walker et al.* (U.S. Patent No. 6,018,718), and in view of the Examiner's Official Notice.

By this Amendment, Applicants amend claims 1-3, 6-8, 11, 15-18, 21-23, 26, 30-33, 36-41, and 43-45, and cancel claims 4, 5, 12, 19, 20, 27, 34, 35, and 42, without prejudice or disclaimer. However, by amending these claims, Applicants do not accede to any of the outstanding rejections. To the contrary, Applicants respectfully traverse the rejections contained in the Office Action. Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 remain pending in this application.

II. Objection to the Specification

In the Office Action, the Examiner objected to the Specification because it contained embedded hyperlinks. (*Office Action*, p. 2.) Applicants hereby amend paragraphs 27 and 28 of the Specification to remove the hyperlinks. Accordingly, Applicants respectfully request withdrawal of the objection to the Specification.

III. Objection to the Claims

In the Office Action, the Examiner objected to claims 5, 15, 19, 20, 30, 35, and 45. With this response, Applicants cancel claims 5, 19, 20, and 35, without prejudice or

disclaimer. Consequently, Applicants submit that the objections to these claims are moot. Claims 15, 30, and 45 have been amended to correct the typographical error pointed out by the Examiner. Accordingly, Applicants request that the objection to claims 15, 30, and 45 be withdrawn.

IV. Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-3, 4-8, 11, 12, 16-18, 20-23, 26, 27, 31-33, 35-38, 41, and 42 under 35 U.S.C. § 112, second paragraph, as being indefinite. With this response, Applicants cancel claims 4, 5, 12, 19, 20, 27, 35, and 42, without prejudice or disclaimer. Consequently, Applicants submit that the rejection of these claims is now moot. Claims 1-3, 6-8, 11, 16-18, 21-23, 26, 31-33, 36-38, and 41 have been amended to correct the antecedent issues listed by the Examiner on pages 2 and 3 of the Office Action. In view of these claim amendments, Applicants respectfully request that the rejections of claims 1-3, 6-8, 11, 16-18, 21-23, 26, 31-33, 36-38, and 41 under § 112 be withdrawn.

V. Rejection of Claims 31-45 Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 31-45 under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Although Applicants respectfully traverse the rejection, Applicants have amended claim 31 to recite a “computer-readable storage medium comprising a stored set of instructions, which when executed by a processor, performs a method for managing a financial account for a customer.” Accordingly, Applicants respectfully request that the § 101 rejection of claim 31, and dependent claims 33, 36-41, and 43-45 be withdrawn.

VI Rejection of Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established for at least the following reasons.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Marshall, Walker et al., and the Examiner’s Official Notice, taken individually or in any proper combination, fail to disclose all recitations of amended claim 1, which recites a method for managing a financial account for a customer, comprising:

- detecting non-credit behavior of the customer, the detected non-credit behavior associated with and benefiting an enterprise;
- determining a reward associated with the financial account for the customer based on the detected non-credit behavior;
- providing an offer to the enterprise, the offer comprising an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior;
- receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer;
- soliciting, based upon the contact information, the customer to open the financial account;
- notifying the customer of the determined reward; and
- opening the financial account based upon a response to the solicitation.

As acknowledged by the Examiner, *Marshall* and *Walker et al.* do not disclose a method for “providing an offer to the enterprise, the offer comprising an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior,” as recited in claim 1. (*Office Action*, p. 8.) To alleviate this deficiency of *Marshall* and *Walker et al.*, the Examiner takes Official Notice. However, an Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable

demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the recitations recited in claim 1 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Further, Applicants submit that “providing an offer to the enterprise, the offer comprising an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior,” in the context of managing a financial account, as recited in claim 1, is not well known. Accordingly, Applicants traverse the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Further, Applicants remind the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

To the extent the Examiner is relying on personal knowledge in taking Official Notice that the features of claim 1 is well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner's conclusions.

Moreover, none of *Marshall, Walker et al.*, and the Examiner's Official Notice disclose "receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer," as recited in claim 1. For the alleged disclosure of this limitation, the Office Action relies on Figure 2, item 215 of *Marshall*. *Marshall* discloses a method of providing an incentives reward program. (*Marshall*, Abstract.) As further disclosed by *Marshall*, profile information of customers enrolling in the program may be "forwarded by a third party to a program administrator." (*Marshall*, ¶ 0080.) However, as recited in claim 1, the acceptance of the offer is received from "an enterprise" and not a "program administrator." Nowhere does *Marshall* teach or suggest receiving an acceptance of the offer from "an enterprise," wherein the offer comprises "an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior," as recited in claim 1. Accordingly, the "program administrator" of *Marshall* does not equate to the claimed "enterprise," and the cited art fails to teach the recitations of the claim.

Consequently, the cited art and the Examiner's Official Notice fail to support the rejection of claim 1 and the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has not clearly articulated a reason as to why independent claim 1 would have been obvious to one of ordinary skill

in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Applicants thereby respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Amended independent claims 16 and 31, although of different scope than claim 1, recite similar subject matter. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 16 and 31 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 are also allowable at least for the reasons set forth above in connection with independent claims 1, 16, and 31, and because they additionally recite features neither taught or suggested by the prior art for record. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Conclusion

The preceding remarks are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any


such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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